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09/593,112	06/13/2000	Theresa M Gosko	M-8811	7080

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EXAMINER

CHANG, SABRINA A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/593,112

Applicant(s)

GOSKO, THERSEA M

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

Applicant's amendments to the specification as well as submission of formal drawings have been made of record and have been considered, Papers 11 and 12.

Response to Arguments

Applicant's arguments filed 7/3/03 have been fully considered but they are not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant argues that the combination of King and Geller are improper because the two inventions stem from nonanalogous art. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Examiner respectfully asserts that the combination of King and Geller was not made in hindsight, further that the two references are in fact related. King discloses a method of managing a catalog system and Geller teaches a method of configuring products. Both systems however are subsets of a larger group generally – product selection in electronic commerce.

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Configurators are well known in the art of e-commerce as a means of putting together products from a wide selection of options. Configurators are simply more complex versions of product catalogs. The two references are therefore not stemming from nonanalogous art and can be combined in the interest of aiding a user in selection/finding of the most relevant/useful product, thereby increasing the likelihood of purchase.

Applicant further asserts that the combination of King/Geller is not sufficient in overcoming the claims as recited. Specifically applicant makes reference to the “automation” of the creation of the catalog. The “automated” nature of the creation of the catalog is only listed in the preamble of the applicant’s independent claims – 1 and 30. There is no supporting description of how exactly the system is “automated” recited in the actual body of the claims. Further, King does in fact disclose automation of a catalog creation process, in that the communication between the private catalogs and supplier catalogs. Examiner draws specific attention to Col 4, Line 27 where private catalogs are created from the supplier catalogs via electronic exchange (thus automatically).

A restatement of the original rejection is stated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1 – 30 rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. U.S. Patent No. 5,319,542 in view of the article “Come, and they will build it” (Geller, Scott. June 1999. *Manufacturing Systems*).

King et al. discloses a system that facilitates a user in electronically ordering items from suppliers. Suppliers manage their own supplier master catalog [Figure 1, Element 106]. Customers can maintain access to their own version of the supplier master catalog, a “private catalog” [Col 4, Line 15. Figure 1, Element 110] (presenting a data file, including a catalog, to a purchaser). The Private catalog can reside on a customer’s host computer system or on a public network and can be maintained by customers or suppliers [Col 4, Line 31] (presenting includes transmitting the data file to the customer or hosting the data file on a world wide web interface – public network). Customers can store catalog items in their private catalogs such as volume purchase agreements, corporate contract discounts, control items, etc. [Col 4, Line 23] (data file includes business rules in a structured data format, data file includes pricing according to predetermined agreements with the manufacturer and the host). Private catalogs are obtained from direct input from the supplier database or are created by the customer [Col 4, Line 27]. Information is transmitted to the customer using Electronic Data Interchange [Col 5, Line 25] (data file is an EDI format). Suppliers can issue separate batch transaction commands modifying unit prices, discounts, payment terms, usage fees, etc. [Col 5, Line 24] (transmitting an action code within the data file denoting product configurations requiring replacement in a procurement system). A customer can order directly from the private catalog, since the source of the catalog item has been pre-approved [Col 5, Line 50] (the data file is configured to be incorporated into a procurement system).

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In specific reference to claims 1 and 7, King et al. does not explicitly disclose that the catalog is one of configurable products including at least one of non-commodity products and services. Geller discloses that “configurators” are well known in the art of electronic catalog display and product ordering. Geller discloses the widespread use of different types of configurators in electronic catalogs including “features and options”, rule-based, object-oriented, table-based and constraint-based configurators. Configurators inherently comprise acknowledgement and notification of acceptable/unacceptable product configuration (Claims 21 and 22).

It would have been obvious to modify the distributed, customer-personalized catalog system of King et al. to include a customer-side “configurator”, as taught by Geller, since configurators are widely known in the art of electronic shopping as a means of enhancing the order-entry process.

In specific reference to claims 2 and 3 the system of King et al. and Geller does not explicitly provide that:

- The purchaser includes at least one of a customer, a third party acting on behalf of the customer and a supplier
- The manufacturer includes a third party acting on behalf of the manufacturer

It would have been obvious to one of ordinary skill in the art to allow any number of parties to participate in the system of King/Geller. The specific party acting, whether the customer, manufacturer or a representative thereof would have been recognized by the skilled artisan as being one of numerous parties suitable for conducting business within the system. The applicant has not persuasively demonstrated that the specific party is anything more than one of the numerous ones that a skilled artisan would have found suitable for the purpose taught by

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King/Geller. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow any number of parties, generally taught as supplier or customer in the system of King/Geller, to participate in the distributed catalog system. .

In specific reference to claims 8, 9, 14, 16 –20, the system of King et al. and Geller does not explicitly provide for a catalog that:

- Includes manipulable parameters that enable configuration of non-commodity products or services, where manipulable parameters include upgrades, downgrades and swapping of components
- Includes non-manipulable parameters that contribute to the configuration of a non-commodity product or service including parent components, orphan components, child components, configuration components and optional components
- Includes a configuration identifier, a price of the configuration, type of components, custom or bundled, upgrades, downgrades and additions permitted with pricing, work flow data identifying add configurations, discontinue configuration, replace configuration, effective data and discontinue data
- Includes at least one of factory-installed components, non-factory installed components, and subsystem configurations – where factory installed, non-factory installed, customer kit and solution data includes the associated Stock Keeping Units (SKUs, including a third parties or a manufacturer generated SKUs and pricing
- Includes a core configuration including commodity and non-commodity default services and customer-specific integration components – where integration components can include customer specific software, menus, images, asset tag labels, security cables, transportation industry options and transportation services

It would have been obvious to one of ordinary skill in the art to provide in the system of King/Geller any number of parameters related to the configuration of the ordered item. The parameter being manipulated, i.e. upgrades, downgrades, etc., would have been recognized by the skilled artisan as being one of numerous parameters suitable for configuration. The applicant has not persuasively demonstrated that the particular parameters are critical or are anything more than one of the numerous parameters that a skilled artisan would have found suitable for the purpose taught by King/Geller. Therefore, it would have been obvious to one of ordinary skill in

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the art at the time of the invention to use any one of the above-mentioned manipulable parameters, generally taught as the process of configuring a product in the system of King/Geller, for the purpose of assembling a customized product.

In specific reference to claims 26 and 27, the system of King et al. and Geller does not explicitly provide that the data file is transmitted to the purchaser using an SGML format or a proprietary file format.

It would have been obvious to one of ordinary skill in the art to provide in the system of King/Geller for the transmission of data from the supplier to the customer using any number of formats. The specific format being used, SGML or proprietary file format, would have been recognized by the skilled artisan as being one of numerous means appropriate for electronic data transfer. The applicant has not persuasively demonstrated that the particular methods suggested in the claims are critical or are anything more than one of the numerous methods that a skilled artisan would have found suitable for the purpose taught by King/Geller. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use either SGML or proprietary file format for transfer, similar to EDI used in the system of King/Geller, for the purpose of transferring a customized data file to the customer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703 308 1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC


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